

### **REMARKS**

This paper responds to the Office Action mailed on January 10, 2007. Claim 1 is amended and claim 3 is canceled such that claims 1-2 and 4-14 are now pending in this application.

#### **Interview Summary**

Applicant's undersigned attorney acknowledges that Species B now includes Figures 3, 4 and 8, as agreed upon in a recent telephone conference with Examiner Patricia Bianco, and confirms the withdrawal of non-elected claims 15-37.

#### **§102 Rejection of the Claims**

Claims 1-3 and 7 were rejected under 35 U.S.C. § 102(b) for anticipation Kuratomi (US 4,747,841). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P. '2131*. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. V. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Office Action states at page 4 that "Kuratomi's heat patch discloses that the first layer is made of gas-permeable or oxygen-permeable (column 2 lines 32-34) material." Applicant respectfully traverses the assertion.

Applicant notes that the entire first layer referred to by the Examiner in the FIG. within the Office Action is NOT gas-permeable. Col. 4, lines 33-35 of Kuratomi specifically states "... pyrogen 5 is accommodated in the inside of the package body 3 which is formed of a non-permeable material . . ." Applicant further notes that air is feed to the pyrogen 5 through feeding holes 13 in the non-permeable package body 3 (see col. 4, lines 50-54 of Kuratomi). Therefore, Applicant respectfully submits that Kuratomi does not teach or suggest "wherein said entire first layer is gas-permeable" as recited in amended claim 1.

Claims 2 and 7 depend from claim 1 such that these claims incorporate all the limitations of claim 1. Therefore, Kuratomi does not teach or suggest the subject matter of claims 2 and 7 for at least the reasons provided above with regard to claim 1.

Reconsideration and allowance of claims 1-2 and 7 are respectfully requested

*First §103 Rejection of the Claims*

Claims 4-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuratomi (US 4,747,841) in view of Argaud (US 4,963,360).

Applicant respectfully traverses the rejection because the combination of Kuratomi and Argaud does not describe each and every element of the claimed invention. As discussed above, Kuratomi does not teach or suggest “wherein said entire first layer is gas-permeable” as recited in amended claim 1.

In addition, the Examiner acknowledges at page 5 of the Office Action that Kuratomi does not disclose a gas-permeable first layer, a second layer and a cover as recited in respective claims 4-6. The Examiner attempts to overcome the acknowledged deficiencies of Kuratomi by combining Kuratomi with Argaud.

Applicant notes that Argaud also does not describe “wherein said entire first layer is gas-permeable” as recited in claim 1. Claims 4-6 depend from claim 1 and as such incorporate all of the limitations of claim 1. Therefore, Applicant respectfully submits that the combination of Kuratomi and Argaud does not teach or suggest a heat patch as recited in claims 4-6.

*Second §103 Rejection of the Claims*

Claims 8-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuratomi in view of Zhang (US 5,658,583). Applicant respectfully traverses the rejection because the combination of Kuratomi and Zhang does not describe each and every element of the claimed invention, and there is no motivation or suggestion to combine Kuratomi and Zhang.

***I. Kuratomi and Zhang do not teach or suggest every element of claims 8-12***

As discussed above, Kuratomi does not teach or suggest “wherein said entire first layer is gas-permeable” as recited in amended claim 1. Applicant notes that Zhang also does not describe “wherein said entire first layer is gas-permeable” as recited in claim 1. Claims 8-12 depend from claim 1 and as such incorporate all of the limitations of claim 1. Therefore, Applicant respectfully submits that the combination of Kuratomi and Zhang does not teach or suggest a heat patch as recited in claims 8-12.

In addition, the Examiner acknowledges at page 6 of the Office Action that “Kuratomi does not disclose a heat patch having a cover including a plurality of portions detachably mounted to the outer surface of the first layer as required by claim 8, does not disclose a heat patch having plurality of portions when removed to regulate the variable temperature that is 38-40° or 40-42° or 42-44° of the heat patch as required by claims 9-12.”

The Examiner attempts to overcome the acknowledged deficiencies of Kuratomi by combining Kuratomi with Zhang.

The Examiner further states at page 7 of the Office Action that “However Zhang discloses a heat patch with plurality of portions detachably mounted to first layer (31 shown in figure 1) and seals the gas permeable first layer, when plurality of portions removes is able to regulate the temperature of the heat patch by exposing the air to the composition (column 11 lines 7-17).”

Applicant respectfully traverses this assertion because the item 31, which was cited by the Examiner, engages the non-air permeable area 24 of the device 10 (see FIG. 1 and col. 6, line 5 of Zhang), and does NOT engage an air-permeable layer as recited in the claims. Therefore, Applicant respectfully submits that the combination of Kuratomi and Zhang does not teach or suggest “wherein said gas-impermeable cover includes a plurality of portions detachably mounted to said outer surface of said gas-permeable first layer” as recited in claim 8.

Claims 9-12 depend from claim 8 and as such incorporate all of the limitations of claim 8. Therefore, Applicant respectfully submits that the combination of Kuratomi and Zhang does not teach or suggest a heat patch as recited in claims 9-12 for the reasons provided above with regard to claim 8.

## II. *There is no motivation or suggestion to combine Kuratomi and Zhang*

Notwithstanding the fact that the combination of references fails to establish all of the elements of the claims, Applicant respectfully submits that the rejection fails to establish a legally sufficient motivation to combine the references. To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The Office Action states at page 7 that:

“it would have been obvious to one skilled in the art to modify the heat patch of Kuratomi with multiple portions mounted on the first layer that is taught by Zhang's device to be able to control temperature between 40°C-45°C by removing portions mounted on the first layer of the device to reach desirable temperature to allow more customize treatment of individual by the heat patch.”

The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Mere conclusory statements are unsatisfactory.

“With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that ‘the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software’ and that ‘another motivation would be that the automatic demonstration mode is user friendly and it functions as tutorial’ do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill in the art would have been lead to this combination of references, simply to use ‘[use] that which the inventor taught against its teacher.’ *W.L. Gore V. Garlock, Inc.*, 721 F. 2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).” *Lee*, at 1343, 1344.

Applicant respectfully submits that the Examiner's statement regarding motivation is analogous to the conclusory statements made by the Examiner and Board in the *In re Lee* case. In addition,

Applicant notes that the Examiner does not cite any authority for the assertion. Applicant respectfully submits that the only teaching or suggestion as to (i) the entire first layer being gas-permeable; or (ii) where the gas-impermeable cover includes a plurality of portions that are detachably mounted to the outer surface of the gas-permeable first layer is found in Applicant's specification and claims.

It is respectfully submitted that the Examiner's assertion as to motivation amounts to a form of Official Notice, which is timely traversed under MPEP 2144.03. Applicant respectfully requests that the Examiner either cite references in support of this position, or provide an affidavit if the Examiner is relying on personal knowledge, as required by 37 C.F.R. 1.104(d)(2).

Since there is no motivation or suggestion to combine the cited references, the rejection should be withdrawn. Reconsideration and allowance of claims 8-12 are respectfully requested.

*Third §103 Rejection of the Claims*

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuratomi and Zhang as applied to claims 8-12 above, and further in view of Ingram (US 5,366,491). Applicant respectfully traverses the rejection because the combination of Kuratomi, Zhang and Ingram does not describe each and every element of the claimed invention, and there is no motivation or suggestion to combine Kuratomi, Zhang and Ingram.

***I. Kuratomi, Zhang and Ingram do not teach or suggest every element of claim 13***

As discussed above, Kuratomi and Zhang do not teach or suggest "wherein said entire first layer is gas-permeable" as recited in amended claim 1. Applicant notes that Ingram also does not describe "wherein said entire first layer is gas-permeable" as recited in claim 1.

Claim 13 depends from claim 1, and as such incorporates all of the limitations of claim 1. Therefore, Applicant respectfully submits that the combination of Kuratomi, Zhang and Ingram does not teach or suggest a heat patch as recited in claim 13 for the reasons argued above with regard to claim 1.

As also discussed above, Kuratomi and Zhang do not teach or suggest "wherein said gas-impermeable cover includes a plurality of portions detachably mounted to said outer surface of said gas-permeable first layer" as recited in claim 8. Applicant notes that Ingram also does not

describe “wherein said gas-impermeable cover includes a plurality of portions detachably mounted to said outer surface of said gas-permeable first layer” as recited in claim 8.

Claim 13 depends from claim 8, and as such incorporates all of the limitations of claim 8. Therefore, Applicant respectfully submits that the combination of Kuratomi, Zhang and Ingram does not teach or suggest a heat patch as recited in claim 13 for the reasons argued above with regard to claim 8.

In addition, the Examiner acknowledges at page 7 of the Office Action that “however Kuratomi and Zhang do not disclose a heat patch having plurality of portions with information related to heat generated by the heat patch when one or more portions is removed from the first layer.” The Examiner attempts to overcome the acknowledged deficiencies of Kuratomi and Zhang by combining Kuratomi and Zhang with Ingram.

Applicant notes that the liquid crystal temperature-indicating strip (22) disclosed in Ingram monitors and displays the temperature of the skin. Applicant initially submits that the strip 22 is not attached to a gas-permeable first layer.

In addition, the disclosed strip 22 is not meant to be removed from the heat pack 1 such that (i) the strip 22 is not detachably connected to the heat patch 1; and (ii) the strip does not provide information as to what happens when the strip 22 is removed because the strip is not meant to be removed. Applicant also submits that the strip 22 does not provide information as to what would happen if the strip 22 were removed from the heat pack 1. Therefore, Ingram does not describe “wherein at least one of said plurality of portions includes information related to heat generated by the heat patch when one or more of said plurality of portions is removed from said gas-permeable first layer” as recited in claim 13.

## II. ***There is no motivation or suggestion to combine Kuratomi, Zhang and Ingram***

The Office Action states at page 8 that

“it would have been obvious to one skilled in the art to modify the heat patch of Kuratomi and Zhang to include the temperature indicating strip of the Ingram's heat patch to allow monitoring the use of the heat patch for therapeutic level without damaging the user's skin with higher temperature.”

Applicant respectfully submits that the Examiner's statement regarding motivation is again analogous to the conclusory statements made by the Examiner and Board in the *In re Lee* case (see quote from *Lee* case above). In addition, Applicant notes that the Examiner does not cite any authority for the assertion. Applicant respectfully submits that the only teaching or suggestion as to (i) the entire first layer being gas-permeable; (ii) where the gas-impermeable cover includes a plurality of portions that are detachably mounted to the outer surface of the gas-permeable first layer; or (iii) one of the plurality of portions including information related to heat generated by the heat patch when one or more of the plurality of portions is removed from the gas-permeable first layer is found in Applicant's specification and claims. Applicant also fails to see how the strip 22 disclosed in Ingram would display proper information if the strip 22 were removed from the heat pack 1 as recited in the claims.

It is respectfully submitted that the Examiner's assertion as to motivation amounts to a form of Official Notice, which is timely traversed under MPEP 2144.03. Applicant respectfully requests that the Examiner either cite references in support of this position, or provide an affidavit if the Examiner is relying on personal knowledge, as required by 37 C.F.R. 1.104(d)(2).

Since there is no motivation or suggestion to combine the cited references, the rejection should be withdrawn. Reconsideration and allowance of claim 13 are respectfully requested.

#### Fourth §103 Rejection of the Claims

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuratomi, Zhang and Ingram as applied to claim 13 above, and further in view of Lachenbruch (US 6,755,852). Applicant respectfully traverses the rejection because the combination of Kuratomi, Zhang, Ingram and Lachenbruch does not describe each and every element of the claimed invention, and there is no motivation or suggestion to combine Kuratomi, Zhang, Ingram and Lachenbruch.

***I. Kuratomi, Zhang, Ingram and Lachenbruch do not teach or suggest every element of claim 14***

As discussed above, Kuratomi, Zhang and Ingram do not teach or suggest “wherein said entire first layer is gas-permeable” as recited in amended claim 1. Applicant notes that Lachenbruch also does not describe “wherein said entire first layer is gas-permeable” as recited in claim 1.

Claim 14 depends from claim 1, and as such incorporates all of the limitations of claim 1. Therefore, Applicant respectfully submits that the combination of Kuratomi, Zhang, Ingram and Lachenbruch does not teach or suggest a heat patch as recited in claim 14 for the reasons argued above with regard to claim 1.

As also discussed above, Kuratomi, Zhang and Ingram do not teach or suggest “wherein said gas-impermeable cover includes a plurality of portions detachably mounted to said outer surface of said gas-permeable first layer” as recited in claim 8. Applicant notes that Lachenbruch also does not describe “wherein said gas-impermeable cover includes a plurality of portions detachably mounted to said outer surface of said gas-permeable first layer” as recited in claim 8.

Claim 14 depends from claim 8, and as such incorporates all of the limitations of claim 8. Therefore, Applicant respectfully submits that the combination of Kuratomi, Zhang, Ingram and Lachenbruch does not teach or suggest a heat patch as recited in claim 14 for the reasons argued above with regard to claim 8.

As also discussed above, Kuratomi, Zhang and Ingram do not teach or suggest “wherein at least one of said plurality of portions includes information related to heat generated by the heat patch when one or more of said plurality of portions is removed from said gas-permeable first layer” as recited in claim 13. Applicant notes that Lachenbruch also does not describe “wherein at least one of said plurality of portions includes information related to heat generated by the heat patch when one or more of said plurality of portions is removed from said gas-permeable first layer” as recited in claim 13.

Claim 14 depends from claim 13, and as such incorporates all of the limitations of claim 13. Therefore, Applicant respectfully submits that the combination of Kuratomi, Zhang, Ingram



and Lachenbruch does not teach or suggest a heat patch as recited in claim 14 for the reasons argued above with regard to claim 13.

In addition, the Examiner acknowledges at page 7 of the Office Action that

“Kuratomi, Zhang, and Ingram do not disclose a heat patch having at least some of plurality of portions are different colors, where the different colors give information related to heat generated by the patch, when one or more portions are removed from the first layer.”

The Examiner attempts to overcome the acknowledged deficiencies of Kuratomi, Zhang and Ingram by combining Kuratomi, Zhang and Ingram with Lachenbruch.

Applicant further notes that the color-coded temperature indicator disclosed in Ingram monitors and displays the temperature of the wrap. Applicant initially submits that the color-coded temperature indicator is not attached to a gas-permeable first layer as recited in the claims.

In addition, the disclosed color-coded temperature indicator in Lachenbruch is not meant to be removed from the wrap such that (i) the color-coded temperature indicator *is not detachably connected* to the wrap; and (ii) the color-coded temperature indicator would not change colors if the color-coded temperature indicator were removed because *the color-coded temperature indicator would not function properly if it were removed*. Applicant also submits that the color-coded temperature indicator would not provide information as what happens to the temperature of the wrap when it is removed from the wrap as recited in the claims. Therefore, Lachenbruch does not describe “wherein at least some of said plurality of portions are different colors, the colors supplying said information related to heat generated by the heat patch when one or more of said plurality of portions is removed from said gas-permeable first layer” as recited in claim 14.

## ***II. There is no motivation or suggestion to combine Kuratomi, Zhang, Ingram and Lachenbruch***

The Office Action states at page 8 that:

“it would have been obvious to one skilled in the art to modify the heat patch of Kuratomi, Zhang and Ingram to include the color-coded temperature indicator which is taught by Lachenbruch to be able to easily see the temperature change on the skin to have fastest response to remove it if temperature rise above the desirable temperature for therapy.”

Applicant respectfully submits that the Examiner's statement regarding motivation is again analogous to the conclusory statements made by the Examiner and Board in the *In re Lee* case (see quote from *Lee* case above). In addition, Applicant notes that the Examiner does not cite any authority for the assertion.

Applicant respectfully submits that the only teaching or suggestion as to (i) the entire first layer being gas-permeable; (ii) where the gas-impermeable cover includes a plurality of portions that are detachably mounted to the outer surface of the gas-permeable first layer; (iii) one of the plurality of portions including information related to heat generated by the heat patch when one or more of the plurality of portions is removed from the gas-permeable first layer; or (iv) where at least some of the plurality of portions are different colors with the colors supplying information related to heat generated by the heat patch when one or more of the plurality of portions is removed from the gas-permeable first layer is found in Applicant's specification and claims. Applicant also fails to see how the color-coded temperature indicator disclosed in Lachenbruch would provide information related to the wrap if it is removed from the wrap as recited in the claims.

It is respectfully submitted that the Examiner's assertion as to motivation amounts to a form of Official Notice, which is timely traversed under MPEP 2144.03. Applicant respectfully requests that the Examiner either cite references in support of this position, or provide an affidavit if the Examiner is relying on personal knowledge, as required by 37 C.F.R. 1.104(d)(2).

Since there is no motivation or suggestion to combine the cited references, the rejection should be withdrawn. Reconsideration and allowance of claim 14 are respectfully requested.

### **Reservation of Rights**

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided

under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record is relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (262) 646-7009 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 28 day of February 2007.

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